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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/686,820

10/16/2003

Manny Manimtim Gabriel

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05/09/2007

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EXAMINER

KIM, WESLEY LEO

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

05/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/686,820

Applicant(s)

GABRIEL ET AL.

Examiner

Wesley L. Kim

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8, 9, 14-16, 18-20 and 22-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 9, 14-16, 18-20 and 22-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/29/07 has been entered.

### ***Response to Amendment***

This Office Action is in response to Amendment filed 1/29/07.

- Claims 1, 4-5, 8-9, 23, 26, 29, 32, 35, and 38 are currently amended.
- Claims 7, 10-13, 17, and 21 are cancelled.
- Claims 1-6, 8-9, 14-16, 18-20, 22-42 are pending in the current Office Action.

### ***Response to Arguments***

Applicant's arguments filed 1/29/07 have been fully considered but they are not persuasive.

- Applicant argues that Bennett does not teach or suggest a system that does not utilize an SMSC facility.

In response to applicant's arguments, the recitation "without traversing Short Message Service Centers situated in said different wireless networks" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose

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of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hira*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-6, 8, 10, 14, 19, 23-31, 33-37, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett et al (U.S. Pub. 2002/0112014 A1) in view of Gunluk (U.S. Patent 5768509), Boltz (U.S. Patent 6311055 B1) and Carrigan (U.S. Pub. 2005/0117602 A1).

**Regarding Claims 1-6, 8, 10, 14-15, 19-20, 23, 26, 29, 35 and 38,** Bennett teaches at least a first hardware device (Fig.1A, SMSC 43a) located in a first wireless communication network (Fig.1A, Cellular Operator A);

said first hardware device being connected to the Internet (Fig.1A, SMSC 43a connected to Internet 40a);

first hardware device having a machine readable storage (Par.47, 13-16, SMSC's can store SMS messages so there is a storage), having stored thereon a computer program comprising a plurality of code sections executable by a machine

for receiving and forwarding SMS messages from the internet to said first wireless communication network and from said first wireless communication network to the internet (Par.50;1-7 and Par.38;1-7, SMSC stores and forwards SMS messages and receives SMS messages also);

at least a second hardware device located in a second wireless communication network (Fig.1A, SMSC 43b); said second hardware device being connected to the Internet (Fig.1A, SMSC 43b connected to Internet 40b);

said second hardware having a machine readable storage (Par.47, 13-16, SMSC's can store SMS messages so there is a storage), having stored thereon a computer program comprising a plurality of code sections executable by a machine for receiving and forwarding SMS messages from the Internet to said second wireless communication network and from said second wireless communication network to the Internet (Par.50;1-7 and Par.38;1-7, SMSC stores and forwards SMS messages and receives SMS messages also).

at least one server that is connected to the Internet (Fig.1A, 24);

said first hardware device receiving an SMS message from a user's SMS device in said first wireless communication network and forwarding said SMS message to said server on the Internet (Par.35;6-13 and Par.36-37),

said second hardware device receiving said SMS message from said server and forwarding said SMS message to said intended recipient in said second wireless communication network (Par.37;6-11), said second hardware device sending a confirmation message to said server after said intended recipient has received said

SMS message (Par.46;6-9); said server having a machine readable storage, having stored thereon a computer program comprising a plurality of code sections executable by a machine for maintaining a plurality of interrelated tables comprising a database (Par.38-46, database contains information on users and mobile network), and Bennett teaches that the database and table contains predetermined routing (Par.39) and identification information for routing SMS messages to selected identified SMS message recipients (Par.38-46, database contains information on user information and each mobile networks information so that messages are properly transmitted), said server obtaining routing information from said database for directing said SMS message to said intended recipient (Par.38-45, database contains information for routing of a message), said routing information including identifying said second wireless communication network (Par.38;1-7, identifies second wireless network and customizes message format information accordingly) and determining the IP address of said second hardware device to which said SMS message will be forwarded (Par.152), forwarding said SMS message to said second hardware device (Par.37), however Knotts **is silent on** said database containing user provided personalized information cross-referencing SMS user devices for routing SMS messages to selected, identified SMS message recipients, said server receiving said SMS message from said first hardware device, analyzing said SMS message and accessing said database to verify that said SMS message originated from an authorized user and to determine the intended recipient of said SMS message, and maintaining account information for debiting said user.

Gunluk teaches that it is well known in the art that a server has the capability to check if the destination is an authorized SMS recipient (Col.1;52-56, this means that there is an allowed/restricted list which a user can send SMS messages to) and Boltz further teaches that it is well known in the art that a user can specify on a server which phone numbers are to be blocked so that outgoing calls to the identified number is restricted (Col.2;20-27), to one of ordinary skill in the art, it would be obvious to also apply this call barring option to the transmission of SMS messages.

Carrigan further teaches that there is a server, i.e. IPG node, which handles the transmission of SMS messages between different networks, including a billing/charging entity (Abstract and Par.96-100).

To one ordinary skill in the art, it would have been obvious to modify Bennett with Gunluk, Boltz, and Carrigan, such that said database containing user provided personalized information cross-referencing SMS user devices for routing SMS messages to selected, identified SMS message recipients, said server receiving said SMS message from said first hardware device, analyzing said SMS message and accessing said database to verify that said SMS message originated from an authorized user and to determine the intended recipient of said SMS message, and maintaining account information for debiting said user, to provide a method where SMS messages will not be accidentally delivered to a destination which the user does not wish to contact, e.g. an unauthorized user, sends a random SMS to a

person you do not want contact, and when SMS messages are delivered, the user is then charged for the services provided by the service provider accordingly.

***With further regards to Claim 18 and 19***, the examiner takes Official Notice that it would be well known in the art to implement a plurality of servers and hardware devices within the network to account of the large number of users within a network. In addition, high traffic can be easily handled by the plurality of hardware devices and servers, so that the users are not bothered with delays of messages or service.

***With further regards to Claim 23***, the examiner takes Official Notice that it is very well known in the art to have information identifying the SMS message user device from which said SMS message was sent.

***With further regards to Claim 26 and 29***, Bennett further teaches that the SMS message is forwarded from the server to recipients email address (Par.52).

**Regarding Claim 3**, the combination as discussed above teaches all the limitations as recited in claim 1, and Bennett further teaches that the cellular phones are connected to computers (Fig.1A;46a, Fig.1A;43a, all these elements are computers and the mobile phone is connected to them).

**Regarding Claim 4**, Bennett teaches that the hardware device is programmed to assist the server device in determining which other hardware device to forward the SMS messages to (Par.36, by forwarding the message to the server, the SMSC has assisted in determining which other hardware device to forward the SMS messages to).



**Regarding Claim 5**, Bennett teaches the server is a computer (Fig.1A, 24).

**Regarding Claim 8**, Bennett teaches that the server device is programmed to forward SMS messages for authorized users of the system to the user's email account (Par.52).

**Regarding Claim 17 and 21**, Bennett teaches SMS messages are forwarded to and received by an SMSC of a wireless communication carrier (Par.37).

**Regarding Claim 22**, Bennett teaches servers exchange information concerning SMS messages (Par.38-45) and user account information exchanged via the internet (Par.38-45).

**Regarding Claims 24, 27, 30, 33, and 36**, Carrigan teaches of performing a pre-paid credit query to see if a user has enough credit to send an SMS message (Par.97-101, it is obvious that the users account will be debited after the message is successfully completed).

**Regarding Claim 25, 28, 31, 34, and 37**, Bennett further teaches an acknowledgement of a successfully forwarded message to the person originating the SMS message (Par.46).

**Regarding Claim 39**, Bennett teaches that 2-way messaging devices send and receive SMS messages (Par.35).

**Regarding Claim 40**, Bennett teaches that a cellular telephone is connected to said input port of said first computer (i.e. gateway) (Fig.1A, mobile is connected to SMSC 43A).

**Regarding Claim 41**, Bennett teaches that 2-way messaging devices (i.e. first computer) send and receive SMS messages (Par.35). It is obvious that 2-way messaging devices, i.e. mobile phones or PDAs or laptops, have a display.

**Regarding Claim 42**, Bennett teaches that a cellular telephone is connected to said output port of said second computer (i.e. gateway) (Fig.1A, mobile station is connected to SMSC 43b).

2. Claims 9, 16 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett et al (U.S. Pub. 2002/0112014 A1) in view of Gunluk (U.S. Patent 5768509), Boltz (U.S. Patent 6311055 B1) and Skog (U.S. Patent 6947738 B2).

**Regarding Claim 9, 16, 32**, the combination of Bennett, Gunluk, and Boltz in the rejection of claim 1 teach all the limitations as recited in claim 32, however the combination **is silent on** (e) determining that said recipient is authorized to retrieve said SMS message from said server via an HTML based interface; and

(f) storing said SMS message until said recipient retrieves it.

Skog teaches that an SMS message is stored until a user retrieves it via an HTML based interface (Col.3;57-65 and Col.9;29-34).

To one of ordinary skill in the art, it would have been obvious to modify Bennett, Gunluk, and Boltz with Skog, such that (e) determining said recipient is authorized to retrieve said SMS message from said server via an HTML based interface; and (f) storing said SMS message until said recipient retrieves it, to provide a method where if the user can retrieve the message when it is convenient

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for the user, e.g, when enough memory has been freed up to accept an SMS message.

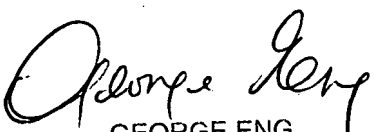
**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesley L. Kim whose telephone number is 571-272-7867. The examiner can normally be reached on Monday-Friday 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WLK



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SUPERVISORY PATENT EXAMINER